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MS APPEAL BRIEF - PATENTS
Docket No.: 0445-0300P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yuji KAWAGUCHI et al.

Application No.: 09/846,459

Confirmation No.: 4434

Filed: May 2, 2001

Art Unit: 3728

For: PAPER CONTAINER

Examiner: J. G. Pickett

APPEAL BRIEF TRANSMITTAL FORM

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 7, 2005

Sir:

Transmitted herewith is an Appeal Brief on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on September 7, 2005.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27.

The fee has been calculated as shown below:

☐ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) - \$0.

☒ Fee for filing an Appeal Brief - \$500 (large entity).

Application No.: 09/846,459

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☒ Check(s) in the amount of \$500 is(are) attached.

☐ Please charge Deposit Account No. 02-2448 in the amount of \$500. A duplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: November 7, 2005

Respectfully submitted,

By 

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November 7, 2005

Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on September 7, 2005, and is in furtherance of said Notice of Appeal.

Applicants herewith appeal the final rejections of claims 1, 3-6, 8, 10, and 11 according to the final rejection of June 7, 2005.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- | | |
|------|-----------------------------------|
| I. | Real Party In Interest |
| II | Related Appeals and Interferences |
| III. | Status of Claims |
| IV. | Status of Amendments |
| V. | Summary of Claimed Subject Matter |

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JWB/RFG/sks

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VI.	Grounds of Rejection to be Reviewed on Appeal
VII.	Argument
VIII.	Claims
IX.	Evidence
X.	Related Proceedings
Appendix A	Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Kao Corporation of Tokyo, Japan as indicated in the Assignment filed on July 2, 2001, and recorded at Reel 011939 and Frame 0506.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1, 3-6, 8, 10, and 11 have been rejected and are being appealed. Claim 7 has been withdrawn from consideration. Claims 2 and 9 have been cancelled.

IV. STATUS OF AMENDMENTS

An Amendment After Final Rejection filed September 7, 2005, was not entered according to the Advisory Action dated September 23, 2005. That amendment attempted to add the limitations of claim 4 to claim 1 in order to reduce the issues on appeal. The Examiner refused entry because amended claim 1 would then raise a new issue with respect to dependent claims 3, 5, 6, 8, 10, and 11 because they had previously not been considered in combination with the limitations of claim 4.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In general, the invention is a paper container 10, as shown in Figure 1, which is used to hold detergent sheets 11 or other products. Because the products can contain oil which seep into the paper structure and make it unsightly, the box is made in two parts including a main body 10 and inner carton part 12. The main body has a lid 14 attached thereto which is formed of a front board 18, a top board 17, and triangular shaped side boards 19. The lid is hinged to the main body along line 28. The inner carton part 12 has a front board 15 containing a cutout which allows the consumer to reach the product within. A flap 26 is provided as a lock to hold the lid in position as shown in Figure 3. Before using the container, the consumer first removes a tear strip 33 which extends from the hinge line 28 obliquely along one side, then across the front, and then obliquely up the other side to the other end of the hinge line. This strip is defined by two lines of perforations 34 and 35 as seen in Figure 4. Due to the manner of hinging and the deep cutout, it is possible to remove the product easily even if the box rests against a wall in the back. The hinge allows the lid to be opened without moving the box forward as is indicated in Figure 1.

Claim 1 is the only independent claim and describes the paper container 10 as having a main body 20 and lid member 14 attached thereto for selectively closing the open surface of the main body. The inner carton part 12 is separate from the main body and is mounted thereon. The cutout part 16 is formed in the front board 15 of the inner carton part. The lid member 14 has an upper surface 17, a front surface 18 and side edge parts 19. The main body and lid are separated by a severance guideline 34 which extends from the opposite ends of connecting ridge line or hinge 28. The guideline extends obliquely downward from opposite ends of this line along sideboards 36 and along the front board 15 below the cutout. An upper half of the front board 15 is above this guideline. The contents can be removed when the lid member extends as far back as the back of the main body (the position shown in Figure 1). The container can store sheet detergent, tablet detergent, or agglomerated detergent.

Dependent claims 3-6 and 8-11 all depend directly from claim 1 and thereby incorporate the limitations indicated above in claim 1. In addition, the dependent claims further include the limitations indicated below.

Claim 3 includes the lock part 26 disposed between the cutout which locks the lower end of front surface 18 of the lid.

Claim 4 describes the paper as being formed from a paper base material, a printed layer, an outer colored film, and an inner film. These layers are shown in Figure 7 as layers 45, 46, 47, and 44, respectively. These layers are described starting at page 12, line 2 of the specification and continue through page 13, line 19.

Claim 5 describes the contents as a packaged detergent.

Claim 6 describes the contents as a sheet-like detergent packaged with a water soluble sheet and stacked in layers and also describes that the inner carton part 12 and the lid member 14 are covered with a moisture proof material.

Claim 8 describes the inner carton part 12 as being made of a single piece.

Claim 10 describes that the contents of the sheet-like detergent or tablet detergent are multi-layered.

Claim 11 describes the inner carton part 12 as having a bottom board (not numbered in the Figures).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, 5, 6, 8, 10, and 11 stand rejected under 35 U.S.C. § 103 as being obvious over Stone (U.S. Patent No. 5,314,114) in view of Stone (U.S. Patent No. 3,963,173), Giblin et al. (U.S. Patent No. 5,320,279), Gottfreid (U.S. Patent No. 5,348,147) and Pritchard et al. (GB 2

264 287). The Examiner indicates that these claims are obvious over the combination of five references.

The Examiner relies on Stone '114 to show a paper container having a container main body, a lid attached to a backside edge part of the container main body and having an upper surface lid part, a front surface lid part, and a pair of side lid parts. An inner carton part with a concave cutout part is formed on the front board and its severance guide line extends obliquely along a pair of side boards and along the front board under the cutout. The Examiner admits that Stone '114 does not show the severance guide line extending from opposite ends of the connecting ridge line or a concave cutout part completely removed from the front board of the inner carton part.

The Examiner relies on Stone '173 to show a container with an inner carton part and a concave cutout part completely removed from the front board and having a severance guideline extending from opposite ends of the connecting ridge line. The Examiner admits that the combination of Stone '114 and Stone '173 does not disclose an inner carton part mounted on and separate from the container.

The Examiner relies on both Giblin et al. and Pritchard et al. to show a container with an inner carton part separate from the container.

The Examiner relies on both Pritchard et al. and Gottfried to show the upper half of the front board being above the severance guideline.

Claim 4 stands rejected under 35 U.S.C. § 103 as being obvious Stone, Stone, Giblin et al, Gottfried, and Pritchard et al. as applied to claim 1 and further in view of Wood et al. (U.S. Patent No. 5,985,772).

The Examiner has added the Wood et al. reference in order to show the packaging material having various layers. The Examiner admits that this feature is not shown in the five-way combination applied to claim 1.

VII. ARGUMENT

Rejection of Claims 1, 3, 5, 6, 8, 10, and 11

First, Applicants submit that it is not obvious to one of the ordinary skill in the art to combine the teachings of these five different references. Likewise, Applicants submit that there is no motivation to one skilled in the art to make such a combination. In answer to Applicants' arguments, the Examiner has pointed out that relying on a large number of references in a rejection does not by itself weigh against the obviousness of the claimed invention. Applicants agree. However, Applicants submit that the Examiner has not shown why one skilled in the art would be motivated to add these various features from the different references in some manner with any specific teaching of the need to do so. The Examiner suggests that Stone '173 provides motivation in Column 1, lines 41-45 by indicating that the containers are provided with a recess to provide ready access to the contents. The Examiner suggests that the addition of Giblin et al, Pritchard et al., and Gottfreid are merely used as evidence to support the case law that merely making separable parts and changes in size are obvious.

Applicants submit that the Examiner has over simplified the combination of references to meet the terms of the claims. In formulating the construction of a paper box, one must not only realize the features in the final product, but must visualize how such features can be added in the process of making the box, which are usually formed by folding from a blank. Accordingly, changing a size or position of an element involves going back to the original blank and considering the layout of the new feature thereon. Applicants submit that one skilled in the art would not seek to make these various changes as suggested by the Examiner without a specific reason for doing so. Applicants submit that a mere mention in a secondary reference of having a recess in front to provide access to the contents, is not sufficient reason for combining all of these features.

Furthermore, the Examiner has suggested that Gottfreid and Pritchard et al. teach that it would be desirable to have deep openings. However, this arrangement is involved with the positioning of the severance guideline so that the upper half of the front board is above this

guideline. The Examiner has listed this as a mere change in the size of the component. However, it relates to the entire arrangement of the parts of the box and is not merely a change in size. Applicants submit that the Examiner has not provided sufficient motivation for one skilled in the art to incorporate these changes. Furthermore, Applicants submit that it would not be obvious to add such a feature to the already tenuous combination of the references. For these reasons, Applicants submit that this five-way combination of references does not render the claims obvious.

Furthermore, in regard to the Gottfreid reference, Applicants disagree with the Examiner's understanding of the reference. Applicants submit that Gottfreid is formed from bottom channel members which leave a major opening in the vertical direction for the removal of papers. This arrangement is covered by a box which covers the four sides but only has flaps to be connected to the bottom. A tear strip is provided just above the flaps so that when they are removed, the entire box except for the flaps is removed to expose the inside portion for easy removal of the paper. Applicants disagree that this reference teaches anything which would help to show the arrangement of the severance guideline as claimed. In the present invention, the severance guideline and tear strip are not used to remove the entire box to expose the inner part only. The Examiner has stated that the reference teaches the idea of having a deep cutout. Applicants submit that this does not teach such an arrangement at all because the box is of a completely different configuration of that of the present invention. In particular, Gottfreid does not discuss a box with a hinged top or similar arrangement. Instead, the tear strip of Gottfreid is used to remove the entire outer container.

Furthermore, Applicants disagree that the Pritchard et al. reference has a severance guideline which is positioned such that the upper half of the front board is above it. The claim defines a severance guideline as extending from the connecting ridge line. Accordingly, the severance guideline can only refer to the upper edge of the tear strip. In Pritchard et al., one can see in Figure 3 that half of the front board is not above the upper edge of the tear strip. This can be further confirmed by using a ruler to measure the relative parts thereof. Thus, Applicants submit that Pritchard et al. is also not a suitable reference for teaching this feature.

For these reasons, Applicants submit that independent claim 1 as well as dependent claims 3, 5, 6, 8, 10, and 11 are not obvious over this combination of references.

Rejection of Claim 4

Claim 4 depends from claim 1 and accordingly is allowable for the reasons as recited above in regard to claim 1. In addition, Applicants submit that it would be even less obvious for one of ordinary skill in the art to combine an additional reference to show the particular layers of paper and other materials used in the container. Applicants submit that there is no motivation to one skilled in the art to use this particular type of material. Accordingly, Applicants submit that claim 4 is further allowable due to lack of motivation for adding the additional reference. Likewise, Applicants submit that it would be even less obvious to one of ordinary skill in the art to use this material in the container suggested by the five-way combination of references. Accordingly, Applicants submit that claim 4 is additionally allowable.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Applicant on January 3, 2005.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS


No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included

XI. SUMMARY

In view of the above, Applicants submit that the final rejection of the Examiner is in error and should be reversed.

Dated: November 7, 2005

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/846,459

1. A paper container having a hexahedral configuration which is formed by shaping paper into a box, said paper container comprising:

a container main body and a lid member hingedly attached to a back side edge part of an upper end open surface of said container main body for selectively closing the upper end open surface,

an inner carton part being mounted on and separate from an inner side of said container main body and a concave cutout part being formed as a complete opening in a front board of said inner carton part said cutout part being large enough to allow removal of contents of said box from a front side, and

said lid member comprising an upper surface lid part for covering said upper end open surface, a front surface lid part large enough to cover said concave cutout part, and a pair of side lid parts interposed between side edge parts of said upper surface lid part and side edge parts of said front surface lid part and adapted to vertically join said front surface lid part with said upper surface lid part,

said container main body and lid member being formed by cutting and dividing said hexahedral paper box through a severance guide line extending from opposite ends of a connecting ridge line between an upper board and a back board of said paper box, and

said severance guide line extending obliquely downward from the opposite ends of said connecting ridge line along a pair of side boards and extending along said front board beneath said concave cutout part formed in the front board of said inner carton so that an upper half of said front

board of said inner carton part is above said severance guide line; and

said cutout part and said lid member being of a size to allow contents of said container to be removed when the upper surface lid part of said lid member extends only as far backward as said back board,

wherein said paper container is for storing a sheet-like detergent, a tablet-type detergent or an agglomerated detergent.

3. A paper container according to claim 1, wherein a lock part is disposed beneath said concave cutout part and adapted to lock a lower end part of said front surface lid part of said lid member.

4. A paper container according to claim 1, which stores an oil containing-content, in which said paper is formed of a paper base material, a printed layer covering an outer surface of said paper base material, an outer colored film covering an outer surface of said printed layer, and an inner film covering an inner surface of said paper base material.

5. A paper container according to claim 1, for storing a packaged detergent.

6. A paper container according to claim 1, for storing a sheet-like detergent which is packaged with a water-soluble sheet and stacked up in layers, and

wherein an inner surface of said lid member in a closed position overlies said inner carton part, and said container main body, said inner carton part and lid member are formed of a moisture-proof material.

8. A paper container according to claim 1, wherein said front board of said inner carton part is made of a single piece.

10. A paper container according to claim 1, wherein said sheet-like detergent or tablet-type detergent are contained in a multi-layered manner.

11. A paper container according to claim 1, wherein said inner carton part has a bottom board.